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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,632	04/02/2004	Kia Silverbrook	HYG003US	2082
24011	7590	05/16/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			FRECH, KARL D	
			ART UNIT	PAPER NUMBER
				2876

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/815,632	SILVERBROOK ET AL.
	Examiner Karl D. Frech	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 36 is/are allowed.
- 6) Claim(s) 1-13,15-24,26-35 is/are rejected.
- 7) Claim(s) 14 and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some.\* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

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1. Applicant's response filed 3/6/06 has been considered. For clarification, the previous Office Action was not made Final as stated specifically in the body of the previous Office Action. The inadvertent error on the Office Action cover page upon which the "FINAL" box was checked is regretted. However, applicant's request that this action not be made final is denied.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4-11,13,15-21,30-33,35 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al 5,128,527.

Kawai discloses coded data to be disposed on a surface of a product, identifying the product. There are disclosed a plurality of coded data portions, including a UPC left block, UPC right block and add-on code. There is disclosed a sensing device, i.e. detector 10, for sensing at least one portion of the code and inherently the product identity distinguishing between products. The UPC itself identifies the product, i.e. second identifier indicative of the item. The add-on code identifies a family of products, i.e. class of products. Although not specifically stated in Kawai, the manufacture information is included in the data held in the UPC code. The add-on code is in the same code format as the traditional UPC code and thus is also interpreted as containing UPC coded information. The left block, right block and add-on of the UPC are interpreted as being sub-layouts. The sub-layouts taken together form the super-layout.

The guard bars and center bar of the UPC are interpreted as target features, and are encoded specifically to indicate the relative position or orientation of the code. Kawai does not specifically disclose that the information in the code is a serial number, however, the actual information in the code does not further define the code structure and is interpreted as merely data. Each of the end bars and the guard bar are made of a plurality of features (individual bars and spaces) and thus at least 4 features are disclosed. The left end bar and the guard bar, or the right end bar and the guard bar indicated a plurality of layouts, i.e. left block and right block. The left end bar indicates the left region of the code; the right end bar indicates the right region of the code. The detector left and right end bars and guard bar are sensed and used to determine the orientation of the code. Thus the left and right end bars and guard bars and the left and right blocks define positions of the data elements within the layout.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12,22-24,26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al 5,128,527. Kawai discloses that which is seen above. Kawai does not disclose the interleaved code. Official Notice is taken that interleaved codes are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to interleave the code of Kawai in order to provide a more "robust" code.

Kawai does not disclose the EPC. However, Official Notice is taken that the EPC code format is old and well known. It would have been obvious to a person of ordinary skill in the art to use the EPC format in Kawai in order to make the Kawai's invention easily implemented in Europe.

Kawai does not disclose the redundancy as claimed. Official Notice is also taken that redundancy in coded information is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide redundant information in the code of Kawai, thereby helping to ensure a readable code in the case where a portion of the code may be damaged.

Kawai does not disclose the invisible code or IR ink. Official notice is taken that bar codes printed in IR ink are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to print the code of Kawai in IR ink. This would effectively obscure the code from the naked eye and thus would not visibly interfere with the surface of a product.

Kawai does not disclose that the code takes up at least 25% of the product surface.

Official notice is taken that codes printed on more than 25% of a surface of a product is known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to print the code on more than 25% of the product surface in order to maximize the amount of information held within the code.

7. Claim 36 is allowable and claims 14 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims for the same reasons as previously set forth.

8. Applicant's arguments filed 3/6/06 have been fully considered but they are not persuasive. Applicant argues that the examiner's interpretation of the current claim is incorrect (see applicant's response page 10, line 25+). The examiner respectfully disagrees. As currently claimed, it is claimed that "the coded data includes a plurality of coded data portions". The UPC does have a plurality of data blocks and, in at least this instance, an add on code. The current claims further recite "...wherein each coded data portion is indicative of an identity of the product item such that sensing any one of the coded data portions allows the identity of the product item to be determined.". However, this wording does not indicate that "any one" of the coded data portions individually or by itself allows the identity of the product item to be determined. As currently worded the claim allows for sensing a plurality of the coded data portions, which further includes possibly sensing all of the plurality of the coded data portions.

9. In response to Applicant's contest of the holding of Official Notice that interleaved codes are old and well known, the examiner presents Ravizza 4,751,375 which clearly states in column 7 line 50 the existence, prior to the filing of this current application, of interleaved codes.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech  
Primary Examiner  
Art Unit 2876

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